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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,333	11/08/2001	Su-Yi Chen	CHEN=332	5127
1444	7590	04/07/2005	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C.			PHAM, TUAN	
624 NINTH STREET, NW			ART UNIT	PAPER NUMBER
SUITE 300			2643	
WASHINGTON, DC 20001-5303				

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/986,333	CHEN ET AL.	
	Examiner TUAN A PHAM	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 November 2004.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2 and 4 is/are rejected.  
 7) Claim(s) 3 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments, see Applicant's remark, filed on 11/16/04, with respect to the rejection(s) of claim(s) 1-4 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bernstein (Pub. No.: US 2003/0026247).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein (Pub. No.: US 2003/0026247) in view of Kikuchi (US patent No.: 5,812,646).

Regarding claim 1, Bernstein teaches a phone adapter device comprising:

a microprocessor utilized to perform a predetermined operation and processing of a predetermined input signal and then output a corresponding signal (see figure 4, DSP 430, col.3, [0039-0042]),

a relay circuit having an amplifier circuit and a relay; when the relay is controlled into operation, the connection of the tip and ring terminals is switched to Voice Over Internet Protocol (VOIP) tip and ring terminals of the microprocessor (see figure 4, relay 460, DSP 430, the relay 460 can be a FET switch that should be included a amplifier, col.4, [0040-0042]),

an off-hook detection circuit connected to the PSTN tip and ring terminals and a ring detection terminal of the microprocessor that is utilized to ascertain telephone off-hook status and send a signal to the ring detection terminal (see figure 4, hook state detector 465, col.4, [0042-0043]), and

a dummy load circuit connected to the tip terminal and the ring terminal of the PSTN for generating an emulated off-hook signals to transmit to the PSTN when the VOIP tip and ring terminals are in use (see col.4, [0048]).

It should be noticed that Bernstein fails to teach the relay circuit having an amplifier circuit and a relay, the relay circuit having an input terminal of the amplifier circuit being connected to the microprocessor and an output terminal of the amplifier

circuit being connected to the signal input terminal of the relay, a terminal at a first side of the relay being connected to a telephone line tip/ring terminal and a terminal at a second side of the relay being connected to a Public Services Telephone Network (PSTN) tip and ring terminals of the microprocessor, the telephone line tip and ring terminals are connected to the PSTN tip and ring terminals. However, Kikuchi teaches such features (see figure 4, control unit 15, amplifier TR3, amplifier TR2, relay A1, relay A2, first side connected to telephone set 11, second side connected to line 1 which is PSTN, col.4, ln.1-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Kikuchi into view of Bernstein in order to provide very low cost long distance as suggested by Bernstein at column 1, [0014].

**4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein (Pub. No.: US 2003/0026247) in view of Kikuchi (US patent No.: 5,812,646) as applied to claim 1 above, and further in view of Freyman et al. (Pub. No.: US 2003/0083009, hereinafter, Freyman”).**

**Regarding claim 2**, Bernstein and Kikuchi, in combination, fails to teach the manual switch for switching between WAN and LAN. However, Freyman teaches such features (see figure 1, switch 40, col.1, [0013], col.2, [0016]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Freyman into view of

Bernstein and Kikuchi in order to provide the connection between WAN and LAN when the switch is switching as suggested by Freyman at column 1, [0007].

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein (Pub. No.: US 2003/0026247) in view of Kikuchi (US patent No.: 5,812,646) as applied to claim 1 above, and further in view of Eftechiou (US Patent No.: 6,002,747).

**Regarding claim 4**, Bernstein and Kikuchi, in combination, fails to teach the off-hook detection circuit consists of two light emitting diodes in a positive-to- negative and negative-to-positive wiring arrangement and a phototransistor. However, Eftechiou teaches such features (see figure 6, LED 120, 140, phototransistor 152, col.12, ln.25-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Eftechiou into view of Bernstein and Kikuchi in order to provide a privacy monitoring as suggested by Eftechiou at column 2, lines48-56.

#### ***Allowable Subject Matter***

6. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In order to expedite the prosecution of this application, the applicants are also requested to consider the following references. Although Wu et al. (Pub. No.: US 2002/0196777) and Akram (US patent No.: 6,868081) are not applied into this Office Action; they are also called to Applicants attention. They may be used in future Office Action(s).
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan A. Pham** whose telephone number is (571) 272-8097. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz can be reached on (571) 272-7499 and  
**IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2643  
March 31, 2005  
Examiner

Tuan Pham



**BINH TIEU**  
PRIMARY EXAMINER